

Application Number 10/828,453

Response to Office Action mailed November 21, 2007

REMARKS

This Amendment is responsive to the Office Action dated November 21, 2007. Applicant has amended claims 1, 4-6, 12, 16, 21, and 28, canceled claim 3, and added claim 29. Claims 1, 2, and 4-29 are pending.

Interview Summary

In a telephonic interview initiated by Applicant on February 11, 2008, Examiner Nordmeyer and Applicant's representatives, Kent J. Sieffert and Jessica H. Kwak, discussed the present application, U.S. Patent Application Serial No. 10/828,453. In particular, the parties discussed the claimed invention in view of the Wright et al. reference (U.S. Patent No. 6,416,857) and Shadle et al. reference (U.S. Patent No. 6,270,122). The parties further discussed proposed amendments to independent claims 1, 6, 12, 16, and 21.

Examiner Nordmeyer appeared to agree that Wright et al. and Shadle et al. do not disclose or suggest a tamper indicating device in which a mask and flood coat are on opposite sides of a backing. Examiner Nordmeyer suggested that Applicant amend the independent claims to clarify that the mask and flood coat are on opposite sides of a backing. The Examiner agreed to consider such claim amendments. However, no formal agreement regarding the claims was reached. There were no exhibits presented or demonstrations conducted during the interview.

Claim Rejection Under 35 U.S.C. § 112

In the Office Action, claims 1-28 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, the Office Action found that independent claims 1, 6, 12, 16, and 21 were vague and indefinite, and claims 2-5, 7-11, 13-15, 17-20 and 22-28 were rejected under 35 U.S.C. 112, second paragraph, due to their dependency on the independent claims. Applicant has amended independent claims 1, 6, 12, 16, and 21 to delete the claim limitations found to be vague and indefinite, thereby rendering the rejection of claims 1-28 under 35 U.S.C. § 112, second paragraph moot. Applicant submits that claims, as amended,

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particularly point out and distinctly claim the subject matter, as required by 35 U.S.C. 112, second paragraph.

Claim Rejection Under 35 U.S.C. § 103(a)

In the Office Action, claims 1, 3, 4, 6, 7, 10-13, 15, 16, 18, 19, 21, 22, 24 and 26-28 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Wright et al. in view of Shadle et al. In addition, claims 2, 5, 8, 9, 14, 17, 20, 23 and 25 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Wright et al. in view of Shadle et al. as applied to claims 1, 3, 4, 6, 7, 10-13, 15, 16, 18, 19, 21, 22, 24 and 26-28 above, and further in view of Mocilnikar et al. (U.S. Patent No. 5,346,259). Applicant respectfully traverses the rejection to the extent such rejections may be considered applicable to the claims as amended. The applied references fail to disclose or suggest the inventions defined by Applicant's claims, and provide no teaching that would have suggested the desirability of modification to arrive at the claimed invention.

With reference to independent claim 1 as amended, for example, the applied references lack any disclosure that would have suggested a tamper indicating device comprising a backing having a first side and a second side, where the backing comprises a first phase and a second phase, wherein the backing has a first level of light diffusion, and when a peeling force is applied to the backing, the backing fractures and has a second level of light diffusion that is a higher level of light diffusion than the first level of light diffusion, a flood coat applied to the second side of the backing, the flood coat defining a window therein, a mask on the tamper indicating device and in partial or whole registration with the window in the flood coat, where the mask and the flood coat are located on opposite sides of the backing, and an adhesive layer bonded to the flood coat.

As the Office Action recognized, Wright et al. fails to disclose a tamper indicating device that includes a flood coat defining a window and a mask in partial or whole registration with the window in the flood coat.¹ The Office Action looked to Shadle et al. to cure this deficiency in Wright et al. According to the Office Action, Shadle et al. discloses an irreversible display having a flood coat defining a window and a mask in partial or whole registration with the window "for the purpose of having a display that temporarily obscur[es] predetermined indicia

¹ Office Action at page 4.

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from view.”² The Office Action characterized the graphics layer 118 shown in FIGS. 12 and 13 as a flood coat defining a window and a metal film 120 as a mask.³

Regardless of whether the graphics layer 118 of Shadle et al. is correctly characterized as a flood coat defining a window and the metal film 120 is correctly characterized as a mask, assertions with which Applicant does not agree, Shadle et al. fails to disclose or suggest that the graphics layer 118 is bound to an adhesive layer. Accordingly, the graphics layer 118 in Shadle et al. cannot be a flood coat defining a window, where the flood coat is bound to an adhesive layer, as recited by Applicant's claim 1 as amended.

As shown in FIG. 14 of Shadle et al, reproduced below, the graphics layer 118 is on an outer surface of the irreversible display device.

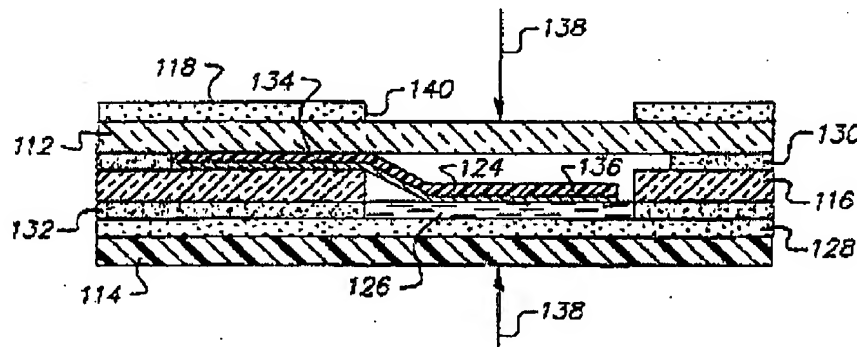


FIG. 14

Shadle et al. discloses that the graphics layer 118 is printed on top of a substrate 112, where the graphics layer 118 provides instructions, information or a decorative design.⁴ Accordingly, Shadle et al. fails to disclose or suggest that an adhesive layer may be bonded to the graphics layer 118 and the substrate 112. Shadle et al. also fails to disclose or suggest that an adhesive layer may be bonded to the side of the graphics layer 118 that opposite the substrate 112.

Even if the tamper indicating device of Wright et al. were modified in view of Shadle et al., the resulting apparatus would not include a backing disposed between a flood coat and a mask. To be clear, modifying the Wright et al. device to include the metal film and graphics layer of Shadle et al. (construed, respectively, by the Office Action as a mask and a flood coat

² *Id.* at pp. 4-5.

³ *Id.*

⁴ Shadle et al. at col. 7, ll. 32-35.

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defining a window) would not result in the particular arrangement of the mask, flood coat, and backing recited in Applicant's claim 1. For example, to the extent the metal film and the graphics layer of Shadle et al. can be construed as a mask and a flood coat defining a window, Shadle et al. requires that the graphics layer (i.e., the "flood coat" according to the Office Action) is printed on an outer surface while the metal film 120 (i.e., the "mask") is internal to the apparatus so as to be in fluid communication with a clearing agent. This structural arrangement is quite the opposite from claim 1 that requires that the mask is "on the tamper indicating device" and further requires an adhesive layer that is bonded to the flood coat.

Further, nothing in the cited references even suggests that the metal film 120 and graphics layer 118 may be positioned on opposite sides of a backing that fractures upon application of a peeling force to the backing. As recited in claim 1, the backing has a higher level of light diffusion upon fracture of the backing. Given the principle of operation of the Shadle et al. device, there is no apparent reason why the backing recited in claim 1 would be positioned between the metal film and the graphics layer. Shadle et al. requires that the indicia in a graphics layer 128 underlying the metal film 120 is visible through a transparent or translucent substrate 112 and clearing agent 126.⁵

The Wright et al. tamper indicating device requires activation in a substantially different way than the Shadle et al. irreversible display, and it is unclear how one skilled in the art would have combined the metal film 120 and graphics layer 118 with the Wright et al. device in order to arrive at Applicant's claimed invention. The Wright et al. tamper indicating device is activated by a force generated from attempting to remove the tamper indicating device from an article, which Wright et al. refers to as a "peel force."⁶ On the other hand, the Shadle et al. device operates by displaying a graphics layer upon squeezing top and bottom substrates 112, 114 of an irreversible display together in order to move a metal film 120 into contact with a clearing agent 126.⁷ If the same "squeezing" force were applied to the Wright et al. device, the tamper indicating device would not activate and no internal delamination would occur.

Given the substantially different structure required for activation of the Wright et al. tamper indicating device and the Shadle et al. irreversible display, one skilled in the art would

⁵ *Id.* at col. 7, ll. 60-67.

⁶ Wright et al. at col. 8, ll. 13-15.

⁷ Shadle et al. at col. 7, ll. 49-54; see also arrows 138 shown in FIG. 14.

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not have looked to combine Shadle et al. with Wright et al. Wright et al. and Shadle et al. describe devices that are activated by substantially different types of "tampering." Wright et al. describes a tamper indicating device that indicates tampering attempts, e.g., attempts to remove the tamper indicating device from an article, through internal delamination.⁸ The internal delamination occurs via a peeling force.⁹ On the other hand, Shadle et al. describes an irreversible display that indicates when the display was squeezed, i.e., a force that moves a metal film into contact with a clearing agent.¹⁰ Shadle et al. does not indicate that its display changes upon an attempt to remove the device from an article, i.e., upon application of a peeling force. Shadle et al. in no way contemplates incorporation of the metal film and the graphics layer into a device that is activated via a peel force.

For at least these reasons, even if Wright et al. was modified in view of Shadle et al., the resulting device would not include a flood coat and mask on opposite sides of a backing, nor would the resulting device include an adhesive layer adjacent to the flood coat. The cited references fail to disclose or even suggest such an arrangement of a flood coat and mask relative to a backing, and, therefore, cannot render Applicant's claim 1 obvious.

The cited references also fail to disclose or suggest each and every element of Applicant's independent claim 6. Claim 6 recites an article including an object having secured information and a tamper indicating device that includes, among other things, a backing, a flood coat, a mask applied to the tamper indicating device such that the mask obscures the secured information, and an adhesive layer attaching the tamper indicating device to the object. According to claim 6 as amended, the flood coat is disposed between the mask and the object, and the backing is disposed between the mask and the flood coat.

As described above with respect to independent claim 1, even if the cited references were combined, the resulting device would not include a backing disposed between a flood coat and a mask. In addition, Wright et al. and Shadle et al. fail to disclose or suggest an article in which a flood coat of a tamper indicating device is disposed between a mask and an object. Even if, for purposes of argument only, the graphics layer 118 of Shadle et al. is correctly characterized as a flood coat and the metal film 120 is correctly characterized as a mask, Shadle et al. fails to

⁸ Wright et al. at col. 1, ll. 9-12 and col. 8, ll. 13-15.

⁹ *Id.*

¹⁰ Shadle et al. at col. 7, ll. 49-54 and FIG. 26.

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disclose or suggest that the graphics layer 118 may be disposed between the metal film 120 and an object. Shadle et al. does not even contemplate attachment of its device to an object having secured information.

The Shadle et al. device 110 has a graphics layer 128 with indicia that may be overlaid by the metal film 120.¹¹ The metal film 120 is in fluid communication with an internal chamber such that the metal film may be moved into contact with a clearing agent 126 (shown in FIG. 13, reproduced above). According to Shadle et al., "[c]ontact between the metal film 120 and the clearing agent 126 clears the metal film 120 . . . revealing the underlying graphics layer 128."¹² After contact with the clearing agent, the metal film becomes clear, thereby allowing the metal film to expose underlying indicia. Thus, Shadle et al. discloses that the metal film 120 is located between the graphics layer 118 (i.e., on an outer surface of the Shadle et al. device) and any secured information. Even if the graphics layer 128 is considered to have secured information, Shadle et al. only contemplates a device in which the metal film 120 is disposed between the graphics layer 128 and the graphics layer 118. Therefore, the graphics layer 118 cannot be a flood coat that is disposed between a mask and an object having secured information, as required by independent claim 6 as amended.

For at least the reasons given above with respect to independent claims 1 and 6, Wright et al. in view of Shadle et al. fails to disclose or suggest each and every limitation of independent claim 12 as amended. Claim 12 as amended recites an article comprising an object having secured information, a tamper indicating backing having a first side and a second side, wherein the backing comprises a first phase and a second phase, wherein the backing is light transmissive, and wherein a peeling force causes the backing to fracture and become more opaque, an adhesive layer applied to the second side of the backing, wherein the adhesive layer is colored, and wherein the adhesive layer is bonded to the application surface of the object, and a mask applied to the tamper indicating device, where the mask obscures the secured information of the object, and where the adhesive layer is disposed between the mask and the secured information, and the backing is disposed between the mask and the adhesive layer.

¹¹ *Id.* at col. 7, ll. 40-42.

¹² *Id.* at col. 7, ll. 60-63.

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As shown in FIG. 14 of Shadle et al., reproduced above, the metal film 120 overlays indicia in the graphics layer 128 that is visible through a window 140 framed by the graphics layer 118.¹³ While an adhesive 132 appears to be positioned between the metal film 120 and the graphics layer 128, the adhesive 132 is absent from the portion of the graphics layer 128 that includes the indicia, i.e., the adhesive 132 is absent from the region of the graphics layer 128 visible through the window 140 framed by the graphics layer 118. Furthermore, Shadle et al. does not disclose or suggest that the adhesive 132 may be colored. Thus, even if the metal film 120 obscures information in the graphics layer 128, Shadle et al. fails to disclose or suggest a colored adhesive layer that is bound to an object having secured information and is disposed between the metal film 120 and the indicia in the graphics layer 128. The colored adhesive would appear to cover any indicia in the graphics layer 128, which would render the Shadle et al. device unsuitable for its intended use. Accordingly, the metal film 120 in Shadle et al. cannot be a mask that obscures secured information of an object, where an adhesive layer is disposed between the mask and the secured information that the mask obscures, as required by independent claim 12.

Applicant's independent claim 16 as amended recites a tamper indicating device including a backing having a first side and a second side, a flood coat applied to the second side of the backing, the flood coat defining a window therein, and a mask on an outer surface of the tamper indicating device, the mask being in partial or whole registration with the window in the flood coat, where the mask and the flood coat are located on opposite sides of the backing. As previously described, Shadle et al. discloses an irreversible display including a metal film 120 that is internal to the display, such that the metal film 120 is in fluid communication with a clearing agent 126.¹⁴ Accordingly, even if Wright et al. were combined with the graphics layer 118 and metal film 120 in Shadle et al., the resulting device would not include a mask on an outer surface of a tamper indicating device. For at least these reasons, claim 16 is patentable over Wright et al. in view of Shadle et al.

Applicant's independent claim 21 is directed toward an article comprising an object having secured information and a tamper indicating device that comprises a backing having a

¹³ *Id.*

¹⁴ *Id.* at col. 7, l. 49 to col. 8, l. 3.

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first side and a second side, a flood coat applied to the second side of the backing, a mask applied to the tamper indicating device such that the mask obscures the secured information of the object, and an adhesive layer attaching the tamper indicating device to the object, where the adhesive layer is adjacent to the flood coat. According to independent claim 21 as amended, the flood coat and the mask are located on opposite sides of the backing. Shadle et al. discloses a device in which the graphics layer 118, i.e., the "flood coat" according to the Office Action, is on an outer surface of the device, such that the metal film 120 is located between the graphics layer 118 and any information that may be located in the graphics layer 128 for viewing through a window 140 framed by the graphics layer 118. The graphics layer 118 on an outer surface the Shadle et al. display device cannot be adjacent to an adhesive layer that attaches the display device to an object having secured information.

For at least these reasons, Wright et al. in view of Shadle et al. fails to disclose or suggest each and every limitation of Applicant's independent claims 1, 6, 12, 16, and 21 as amended. Mocilnikar fails to overcome the fundamental deficiencies in Wright et al. and Shadle et al. Claims 2, 4, 5, 7-11, 13-15, 17-20, and 22-28 depend from one of independent claims 1, 6, 12, 16 or 21, and, therefore, are also patentable over the cited references. In addition, claims 2, 4, 5, 7-11, 13-15, 17-20, and 22-28 recite additional limitations that are neither disclosed nor suggested by the cited art. For example, claim 2 recites at least one security marking applied to the first side of the backing, where the security marking has substantially the same color as the flood coat. With respect to the rejection of claim 2, the Office Action reasoned that Mocilnikar teaches an anti-theft label where the security marking has the same color as the flood coat and cited to column 4, lines 34-43 of Mocilnikar. Applicant respectfully disagrees.

Applicant believes the Office Action is characterizing the PET film layer 32 of the Mocilnikar label as a flood coat defining a window and the authentication pattern 16 as a security marking. Mocilnikar describes its PET film layer 32 as being clear.¹⁵ The authentication pattern 16 is defined by an indicia layer 40. In particular, the authentication pattern 16 is viewable by placing an authentication viewer 14 over the Mocilnikar label, where the authentication viewer 14 allows an observer to view alternate lines of graphics in the layer 40.¹⁶ The PET film layer 32

¹⁵ Mocilnikar at col. 4, ll. 58-62.

¹⁶ *Id.* at col. 5, ll. 10-26.

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is clear in order to allow printing in the layer 40 to be visible.¹⁷ Accordingly, the PET film layer 32 of Mocilnikar cannot be a flood coat defining a window and the authentication pattern 16 cannot be a security marking that has substantially the same color as the flood coat.

Reconsideration and withdrawal of the rejection of claims 1, 2, and 4-28 under 35 U.S.C. § 103(a) is respectfully requested in view of the foregoing remarks.

New Claim

Applicant has added claim 29 to the pending application. The applied references fail to disclose or suggest the invention defined by Applicant's new claim 29, and provide no teaching that would have suggested the desirability of modification to arrive at the claimed invention. No new matter has been added by the new claims.

CONCLUSION

All claims in this application are in condition for allowance. Applicant respectfully requests reconsideration and prompt allowance of all pending claims. Please charge any additional fees or credit any overpayment to deposit account number 50-1778. The Examiner is invited to telephone the below-signed attorney to discuss this application.

Date:

By:

February 21, 2008

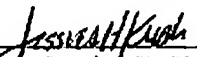
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¹⁷ *Id.* at col. 6, ll. 3-11.